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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,502	06/19/2001	Jeffrey A. Bedell	53470.003037	8691
21967 7590 12/02/2008 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109				
EXAMINER				
HUYNH, CONG LAC T				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/883,502

Applicant(s)

BEDELL ET AL.

Examiner

Cong-Lac Huynh

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date: _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: response filed 9/9/08 to the application filed on 6/19/01.
2. Claims 1-28 are pending in the case. Claims 1, 6, 14, 21 are independent claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-28 remain rejected under 35 U.S.C. 102(e) as being anticipated by Alexander et al. (US 2002/0069207 A1, 6/6/02, filed 12/6/00).

Regarding independent claim 6, Alexander discloses a method for creating a report comprising steps:

- selecting a template with one or more template properties ([0006]-[0008], [0040]: generating a report based on a selected survey where a report has format properties such as full, brief, specific question, and statement, and each report when applied the selected format is considered a template for filling data from the survey)

- selecting a filter with one or more filter properties ([0040]: when selecting one of the format properties, the data included in the report is filtered to be included only data required by the selected format)
- specifying one or more of the template or filter properties with a prompt object ([0024], [0040]: each formatted report is selected to comply with the selected survey)
- wherein the prompt object comprises:
 - o a question to be asked of a user (figure 2, [0006]-[0009])
 - o a prompt type ([0034]: survey, which is equivalent to a prompt object, is classified by types such as medical, political, or product preference)
 - o at least one validation property ([0027], [0029]: values assigned to the answers for validating right answers)
 - o wherein the prompt object is used in creating a report to be executed in a reporting system, wherein the report may specify a prompt object as a property of the report, and wherein the prompt object is an object separate from the report such that the prompt object may be used more than once in a single report or may be used in more than one report ([0008]-[0009], [0029], [0034]: the survey, which is considered the prompt object can be reused more than once in a single report or may be used in more than one report)

Regarding claim 7, which is dependent on claim 6, Alexander discloses that at least one validation property comprises verification that the answer provided to the question is of the specified prompt type ([0027, [0029]], [0034]: the values assigned to the answers to the questions are validation properties verifying that the provided answer is of the specified prompt type since for medical survey, there are different questions and answers than for a political survey or product preference survey).

Regarding claim 8, which is dependent on claim 6, Alexander discloses that the prompt object further comprises a default answer to the question (figure 2).

Regarding claim 9, which is dependent on claim 6, Alexander discloses that the prompt object further comprises a meaning that, upon request by a responder to the prompt, provides an explanation of the question (figure 4).

Regarding claim 10, which is dependent on claim 6, Alexander discloses that the prompt object further comprises a reuse value that indicates whether an answer provided from a previous instance of that prompt object, a default value or a new value is to be used for an answer to the question in the prompt object ([0034]).

Regarding claim 11, which is dependent on claim 6, Alexander discloses specifying a single prompt object for a plurality of properties in the report and wherein upon report execution, the question receives only one answer that is provided to each property for

which the prompt object was specified ([0034]-[0035], figure 3: indicating a specific topic of a survey, which is considered a property of the survey, such as medical practice, family history, or social history would cause the report execution to receive only one answer provided to each type of survey, which is considered equivalent a prompt object).

Regarding claim 12, which is dependent on claim 6, Alexander discloses specifying at most one prompt object for a template or filter property ([0040]: specifying at most a survey with a survey ID to generate a report format, which is considered equivalent to a template).

Regarding claim 13, which is dependent on claim 6, Alexander discloses that the template comprises a set of templates properties and the filter comprises a set of filter properties and wherein every template and filter property may be specified as a prompt object ([0040]: the report format has a set of format properties, and upon selecting one of the format properties, the report is generated so that data included in the report is limited to the requirement of the report format; in other words, a filter with filter property is implied in generating a report).

Claims 1-5 are for a prompt object as mentioned in claims 6-10, and are rejected under the same rationale.

Claims 14-20 are for a processor-readable medium of method claims 6-10, and are rejected under the same rationale.

Claims 21-28 are for a system of method claims 6-13, and are rejected under the same rationale.

Response to Arguments

5. Applicant's arguments filed 9/9/08 have been fully considered but they are not persuasive.

Applicants argue that Alexander does not disclose at least a "prompt object comprising: ... a prompt type; and at least one validation property," as expressly recited in claim 1 and the prompt object in the claimed invention includes both a prompt type and a question (remarks, pages 7-8).

Examiner respectfully disagrees.

Alexander discloses that a survey includes a single question or a set of questions ([0006]) and each survey is an object in object-based computer programming with associated properties such as title, subheading, questions, answers and values ([0029]). The survey in Alexandria, thus is equivalent to a prompt object as disclosed in the specification (page 16, line 14, "a prompt object includes a question").

Alexander discloses that surveys are classified by types such as political, medical, or product preference types where *each type has different question and answer pairings* ([0034]). The survey thus, includes both question and prompt type as argued.

Alexander also discloses creating and entering the question and answer pairings to a survey ([0008]) where each answer is assigned a value and the values for the answers of a survey are properties of the survey ([0027], [0029]). Since each type of survey has a different set of questions and answers and each answer is assigned a specific value, it is clear that the answer value is the information for validating the properness of the answers to the questions in each survey of different type.

This is equivalent to the validation value as disclosed in the specification of the invention that is used to ensure that the answer is valid (specification, page 3, lines 5-9, page 14, lines 18-21, page 16, lines 15-19). Therefore, Alexander discloses a validation property.

Applicants also argue that Alexander does not disclose "at least one validation property comprises verification that the answer provided to the questions is of the specified prompt type" (remarks, page 9).

The Examiner respectfully disagrees.

Alexander discloses that a catalog is "a set of question and answer pairings", "preferably arranged and classified by type" where each type of survey has specific questions and answers ([0034]). The fact that each answer to a question is *assigned a specific value* as mentioned above and *each question and answer pairing is classified by type* shows that each value assigned for an answer is a verification of a specified survey type, which is a prompt type.

Regarding the declaration under 37 C.F.R. 1.131, the rejection on this issue remains since there is no specific argument from Applicants as well as no amendment for the declaration is submitted to overcome the rejection.

Response to Amendment

6. The declaration filed on 10/2/05 under 37 CFR 1.131 has been considered but is ineffective to overcome the Alexander reference.

Regarding the Declaration, it is unclear what Applicants would like to establish: 1) conception coupled with due diligence or 2) reduction to practice prior to the effective date of the reference in the submitted declaration, since both are mentioned in the declaration and in Applicants' remarks. Applicants should consider filing a proper declaration in light of MPEP 715.07 (III) and MPEP 715.07 (a).

In any case, Exhibit A submitted as a written description of the invention, do not constitute an actual reduction to practice or establish conception coupled with due diligence. Furthermore, only the filing of a US patent application which complies with the disclosure requirement of 35 USC 112 constitutes a constructive reduction to practice. A written description, no matter how complete, which has not been made the subject of a US patent application, does not qualify as reduction to practice or conception coupled with due diligence.

Accordingly, Applicants have not established prior invention. The rejection is maintained.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The prior art of record is listed on PTO 892.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Thurs (8:30-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cong-Lac Huynh/
Primary Examiner, Art Unit 2178
11/21/08